

REMARKS

The Office Action mailed February 26, 2004 has been carefully considered. Reconsideration of this application, in view of the following remarks, is respectfully requested.

The Claims

Claims 1 – 9, 11 – 23, 25 – 37 and 39 -45 are pending in this application, including independent claims 1, 15 and 29. An amendment was made to claim 13 to correct a typographical error.

35 U.S.C. 103(a)

In the Office Action, claims 1 – 9, 11 – 23, 25 – 37 and 39 -45 were rejected, in paragraph 8, under 35 U.S.C. § 103(a) as being unpatentable over Biliris et al. (US 6,442,546), hereafter Biliris. This rejection is respectfully traversed, in view of the following arguments, because a *prima facie* case of obviousness has not been made in the Office Action.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP 2143 at pp. 2100-124 – 125 (citations omitted.)

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Biliris does not teach or suggest the claim limitations as recited in the Office Action

The Office Action interprets the claim requirement of an e-mail message addressed to a nickname address of a recipient as teaching the use of e-mail aliasing and acknowledges that Biliris does not teach e-mail aliasing.

As a preliminary matter, the Office Action recites a definition for e-mail aliasing from **Newton's Telecom Directory** without indicating the date of publication for that definition. Applicants are entitled to know that such a definition existed in that reference prior to Applicants' filing date of 7/11/2000.

Assuming for the sake of argument that teaching recited in the Office Action pre-dates the filing of the subject application, it would appear that the content of the definition recited suggests that one uses e-mail aliasing for the sole purpose of choosing a more convenient e-mail address (e.g., an address that is easier to remember.) The definition provided implies that there is one destination messaging service which receives messages directed to both the user's actual and alias e-mail address; the messaging service provides the translation from alias address to actual address.

In Claims 1, 15 and 29 of the subject application, an e-mail invoked application server receives the e-mail addressed to the nickname address, determines an actual address of the recipient, transmits the e-mail message to the actual address of the recipient utilizing the network. The Office Action fails to point out, in either Newton's Telecom Directory or in Biliris where these additional elements of claims 1, 15 or 29 are taught. The messaging system in Biliris does not appear to perform these operations. Indeed, apart from user message 222 being transmitted over communication network 104 (col. 2, lines 50-51), the only reference to a message being transmitted appears to be the statement at col. 2, lines 61 – 63 which states "Optionally, notification messages 208 may be sent to the recipient system, to notify the message recipients that message 204 is

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available for access.” Biliris states that “[m]essage 204 is then stored in one or more messaging servers 102A-Z, where it is available for access by any user system, such as user system (recipient) 210A-Z to which the message is addressed.” Biliris, col. 2, lines 57 – 61. Storing a message is not functionally equivalent to transmitting it utilizing the network. Indeed, in independent claims 1, 15 and 29, the e-mail message received by the e-mail invoked application server to the nickname address is then transmitted to the actual address, which is arguably less efficient than the messaging system taught in Biliris.

Similarly, with respect to the limitations of claims 14, 28 and 42, it is respectfully submitted that Biliris does not teach these claim elements. The Office Action recites no passages in Biliris that teach these claim limitations. The “database” in Biliris appears to be the user messages, folders and attributes. (See Figs 3 and 6). There is simply no discussion in Biliris for generating summaries of messages, folder contents or attributes and storing those summaries. While it might occur to a person of ordinary skill in the art to summarize information in a data base, this is not a suitable “teaching” sufficient to constitute a *prima facie* rejection under 35 U.S.C. 103(a) for these claims.

The Office Action fails to state plausible motivations, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the Biliris reference to make the claimed invention.

The rejection of claims 1, 15 and 29 as premised on the combination of the Biliris messaging system and the use of e-mail aliasing as taught in Newton’s Telecom Directory fails to provide any teaching of a suggestion or motivation to make the combination. As already noted above, the recited teaching of the use of e-mail allasing for convenience makes no mention of the operations of determining the actual e-mail address and transmitting the email to the recipient at the actual address, nor suggests these operations as a possible reason to use e-

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mail aliasing. The Office Action fails to state why the Biliris messaging system should be modified to adopt e-mail aliasing. It is respectfully suggested that, at most, the Biliris messaging system might adopt the view of e-mail aliasing as set forth in Newton's Telecom Directory and allow for some type of translation function where a message addressed to a nickname address is received by the messaging system in Biliris, somehow matched to a valid address that is then processed in Biliris's messaging system without further transmission. Or, perhaps the alias address is redirected to a valid address before reaching the messaging system in Biliris. Either functionality, however, is different from what is claimed in independent claims 1, 15 and 29. It is implausible and impermissible to manufacture the motivation to combine the Biliris reference with knowledge of e-mail aliasing to leap to the functionality expressed in claims 1, 15 and 29. Indeed, as already noted above, in independent claims 1, 15 and 29, the e-mail message received to the nickname address is then transmitted to the actual address, which is arguably less efficient than the messaging system taught in Biliris.

While it is possible to show the motivation to make an asserted combination using the knowledge of persons of ordinary skill in the art, it is not sufficient to simply rely on some "high level of skill in the art" to provide the necessary motivation without explaining what specific understanding or technological principle within the knowledge of one of ordinary skill in the art would have suggested the combination. See *In re Rouffet*, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998). The only technological principle presented in the Office Action is that "e-mail aliasing is a common and well-known practice in the art for providing a simpler method of addressing an e-mail." The Office Action seems to suggest that a person of ordinary skill in the art at the time the invention was made and knowing about e-mail aliasing would have modified the messaging system of Biliris to receive an e-mail message to a nickname address, match it to an actual address, then transmit the message over the network again to the messaging

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system before processing it. It is respectfully suggested that this motivation is flawed.

**Rejections of Some of the Dependent Claims Impermissibly Use
Hindsight**

The Office Action acknowledges that limitations in dependent claims 4, 18, 32, 7, 21, 35, 8, 22, 36, 9, 23, 37, 11, 25, 39, 43, 44 and 45 are not taught in Biliris. In each of these rejections, the Office Action relies on a person of ordinary skill in the art at the time the invention was made for both the teaching of the claim element and the motivation to modify the messaging system disclosed in Biliris to make the asserted combination.

For example, with respect to claims 9, 23, and 37, the Office Actions states as its *prima facie* rejection of these claims that "[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a reply to an e-mail to obtain information for the database." It is respectfully suggested that to arrive at this result requires using the teachings of the subject application in hindsight. To the contrary, it is perfectly reasonable to conclude that a person of skill in the art at the time the invention was made using a conventional e-mail system, or even the messaging system disclosed in Biliris, would not expect that replying to an e-mail would produce information from a data base. Moreover, the Office Action provides no motivation for modifying the messaging system in Biliris to provide for e-mail replies that produce information from a data base, nor does the Office Action state which data base in Biliris that might be. It is respectfully suggested that each of these rejections of the dependent claims is based on equally vague, general and unsupported reasoning and do not constitute *prima facie* rejections under 35 U.S.C. 103(a).

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Reconsideration Requested

The undersigned respectfully submits that, in view of the foregoing remarks, the rejections of the claims raised in the Office Action dated February 26, 2004 have been fully addressed and overcome, and the present application is believed to be in condition for allowance. It is respectfully requested that this application be reconsidered, that these claims be allowed, and that this case be passed to issue.

In the event the Examiner considers personal contact advantageous to the disposition of this case, he is hereby authorized to call Applicant's attorney, Daniel Curtis, at Telephone Number (650) 812-4259, Palo Alto, California.

Respectfully submitted,



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